



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/529,211 | 01/17/2006 | Bo E. Samuelsson | 19200-000045/US | 2024 |
| 30593 7590 04/28/2009 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195 | | | | |
| EXAMINER | | | | |
| NGUYEN, CAMTU TRAN | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3772 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/28/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,211

Applicant(s)

SAMUELSSON, BO E.

Examiner

Camtu T. Nguyen

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responding to applicant's amendment filed on 5/6/2008. Claims 1-4 have been amended. Claims 9-20 are newly added.

Applicant's response to the Objection against the specification (filed 9/27/2007) in the previous Office Action deemed persuasive. Thus, such Objection has been withdrawn.

Applicant's response to the 112, 1st paragraphs applied in the previous Office Action, deemed persuasive. Thus, such rejections have been withdrawn.

Applicant amended claim 1 to now also recite the second part (4) further includes a stiffer portion configured to be at least partially disposed in the second person's urethra of sexual organ. Such recitation distinguished over cited prior art of Herr, thus, such rejection applied against independent claim 1 has been withdrawn.

Newly added claims 9-20, however, have been carefully considered but are rejected as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Herr (U.S. Patent No. 5,458,114).

Herr discloses a penile cap (1) comprising a first part (3) and a second part (5), both of which are made from elastic material (column 2 line 46, column 3 lines 12-15 & lines 45-49), the first part (3) has an inner side or the lower surface (9) coated with a layer of adhesive (14) to secure the cap (1) to the penile glans (10), see column 3 lines 23-33.

With regards to claim 11 reciting when the membrane ruptures, seminal fluids of the second person can flow through the device, Figure 2 in the Herr reference illustrates when the membrane (5) ruptures, the seminal fluid can flow through the device (1).

With regards to claim 12, the Herr discloses in Figure 5 lower surface (9) of first part (3) is substantially a bending disk.

With regards to claims 13 & 15, Figure 2 in the Herr reference illustrates the middle/end part of the first part (3) merges into the second part (5).

With regards to claim 14 & 16, Figure 2 in the Herr reference illustrates the first part (3) is fixed over the mouth of the urethral orifice (11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herr (U.S. Patent No. 5,458,114).

Herr discloses a penile cap (1) comprising a first part (3) and a second part (5), presented above.

With regards to claim 17, the Herr reference discloses the layer of adhesive (14), which functions similarly in manner to that of a bandage having adhesive, retains fastening capacity of the penile cap (1) to the glans skin under action of normal bodily fluids.

With regards to claims 18-19, it is well known in the art that ethanol can be used to remove glue or tacky substances. In fact, applicant discloses its availability in the specification on page 6 lines 16-20. Therefore, it would have been obvious to one skilled in the art at the time of the invention to employ the well known technique, including applicant's own admission that it is known, to utilize ethanol as the solvent agent to remove the adhesive from the device of Herr when one chooses to dissolve the glue.

With regards to claim 20, the Herr reference discloses the first component in the form of a removable protective cover (21) as shown in Figure 5, the cover (21) is preferably made from a thin sheet of paper, rubber, plastic or similar material which is easily peeled away from the adhesive layer (14) prior to installation (column 4 lines 42-53). The Herr does not disclose the second component recited in claim 8. However, since applicant's specification does not disclose what the second component is other than it is to be applied to the man's glans (page 6 lines 9-12), thus providing no criticality to the composition of the second component, it would have been obvious to one skilled in the art at the time of the invention to have used a skin glue, as it is sometimes called in the field, as the second component to be administered on the user's penile

glans such that fix the penile cap device to the user's penile glans (10). Skin glue is a known copolymer of an acrylic ester and acrylic acid used in the art.

Allowable Subject Matter

Claims 1-8 are allowed.

The following is an examiner's statement of reasons for allowance: the art of record when applied alone or in combination neither renders obvious a device for preventing transmission of bodily fluids during sexual relations from a first person to a second person wherein the device comprising all of the elements as recited in independent claim 1 including the second part further includes a stiffer portion configured to be at least partially disposed in the second person's urethra.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 571-272-4799. The examiner can normally be reached on (M-F) 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/529,211
Art Unit: 3772

Page 7

/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772